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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,828	11/21/2001	David G. England	42390P6233C	2169

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

WONG, ALBERT KANG

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 05/16/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/991,828

Applicant(s)

ENGLAND, DAVID G.

Examiner

Albert K Wong

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-42, 48, and 50-54 is/are rejected.
- 7) ☒ Claim(s) 43-47 and 49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2635

1. This Office action is in response to the Continuing application filed November 21, 2001. claims 30-54 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 50, 51, 53 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda.

Regarding claim 50, the claimed base is shown as item 3, the display is shown as item 2, and the attachment means is shown as item 9.

Regarding claim 51, see joint that attaches pivot to base.

Regarding claim 53, Figure 3 shows a sliding mechanical guide.

Regarding claim 54, the electrical contact means is inherent since there must be some electrical means to couple a signal to the display.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 52, 42, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conway.

Regarding claim 52, Conway teaches a computer with a base and a display with an attachment means that electrically and mechanically connects the display with the base and conceals the keyboard and does not conceal the keyboard. The ball joint constitutes the single arm attachment means. Although the drawings suggests that the display is not large enough to conceal the entire keyboard, it would have been obvious that the size of the display is not limited and that any size of a display would be contemplated.

Regarding claim 42, Conway shows a base with a keyboard and a display. Figures 1A and 1B show that the device may be placed in the claimed first and second position and remain coplanar. Although the drawings suggests that the display is not large enough to conceal the entire keyboard, it would have been obvious that the size of the display is not limited and that any size of a display would be contemplated. The single pivot point is shown as the ball joint.

Regarding claim 48, the elements recited in claim 30 have been addressed in claim 42. The arm in Conway has at least 3 degrees of freedom of movement.

6. Claims 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of Ku.

Regarding claim 30, Haneda teaches the claimed base with a keyboard as item 3, the display is shown as item 2. Figure 5 and 8a-b show the display in the concealed position and the exposed position. Each position is substantially coplanar. Haneda teaches that the base unit includes keys but the keys are not input buttons. Ku teaches a computer base with key input buttons is Figure 2. The display is also moveable in a variety of positions. It would have been obvious to use keys instead of the touch pad because they are functionally equivalent.

Art Unit: 2635

Regarding claim 31, both references teach a mechanical coupling means to couple the display to the base.

Regarding claims 32-33, it is conventional for a computer keyboard to include a full set of letters and numbers.

Regarding claim 34, Haneda does not require the use of an arm.

Regarding claim 35, Haneda does not require the use of a ball joint to pivot the display.

Regarding claims 36-37, see mechanism in Haneda.

Regarding claim 38, Haneda shows an arm which may be considered a part of the base with a protrusion that fits in the groove in the display. It would have been obvious that the groove and the protrusion may be reversed since it is only required that the two parts interlock.

Regarding claim 39, if we consider item 9 to be part of the base then it would constitute the protrusion and the groove is shown as item 2a in Haneda.

7. Claims 43-47 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2635

9. Claims 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 11 of U.S. Patent No. 6,483,445. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are anticipated by claims 10 and 11 of the Patent.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See cited art for further examples of attachment means for computer keyboard bases with displays.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 703-305-8884. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Albert K. Wong
May 12, 2003